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MAR 16 2007

PATENT APPLICATION

ATTORNEY DOCKET NO. 10014526-1

(HDP#6215-000039/US)

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Daniel E. FORD et al.

Confirmation No.: 3479

Application No.: 10/082,245

Examiner: Jeffrey R. Swearingen

Filing Date: February 26, 2002

Group Art Unit: 2145

Title: REMOTE INFORMATION LOGGING AND SELECTIVE REFLECTIONS OF LOGGABLE
INFORMATION

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL FOR REPLY BRIEF

Sir:

Transmitted herewith is a Reply Brief, which is response to the Examiner's Answer mailed January 16, 2007.

No fee is believed to be due at this time for filing this Reply Brief

Please charge to Deposit Account 08-2025 the sum of \$0.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally, please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

CERTIFICATION OF FACSIMILE TRANSMISSION

Applicant: Daniel E. FORD et al.
Atty Docket No. 10014526-1 (HDP#6215-000039/US)
Serial No.: 10/082,245, Filing Date: February 26, 2002
Title: REMOTE INFORMATION LOGGING AND SELECTIVE REFLECTIONS
OF LOGGABLE INFORMATION
Number of Pages: 4

I hereby certify that the papers itemized below are being facsimile
transmitted to the Patent and Trademark Office on March 16, 2007 to
facsimile number 571-273-8300.

• Reply Brief (3 pages)

Typed Name: Cate Malychuk

Signature: Cate Malychuk 3/16/07

Respectfully submitted,

Daniel E. FORD et al.

By: 

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANT: Daniel E. FORD et al. CONF: 3479
SERIAL NO.: 10/082,245 GROUP: 2145
FILED: February 26, 2002 EXAMINER: Jeffrey R. Swearingen
FOR: REMOTE INFORMATION LOGGING AND SELECTIVE REFLECTIONS
OF LOGGABLE INFORMATION
ATTY. DKT. NO.: 10014526-1
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REPLY BRIEF**March 16, 2007**

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401 Dulany Street
Alexandria, VA 22314

Sir:

This Reply Brief is responsive to the Examiner's Answer mailed January 16, 2007. Appellant has carefully reviewed the Examiner's Answer and reiterates that the Final Rejection (mailed April 11, 2006) of Claims 1, 4-10, 24-26 and 33-35 should be reversed for the reasons presented in Appellant's Appeal Brief (filed October 16, 2007) and for the following Remarks supplemental thereto. The Supplemental Remarks respond to several new points presented in the Examiner's Answer.

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I. IMPERMISSIBLE HINDSIGHT

Previously, Appellant argued (see, e.g., Appellant's Appeal Brief, §§ VII.A.v~vi, pp. 9~10) that the Examiner's obviousness rationale is of the impermissible "invention could have been made" variety of obviousness rationales.¹ This is a first variety of impermissible hindsight.

Appellant further regards the Examiner's obviousness rationale as including a second variety of impermissible hindsight.

II. AT TIME INVENTION MADE, NOT AT TIME REJECTION MADE

The proper time perspective, regarding what adaptations to the prior art would have been made by the skilled artisan, is at the time the invention was made, not at the time of making the rejection.² As stated in MPEP § 2141.01.III:

The requirement "at the time the invention was made" is to avoid impermissible hindsight. ...

"It is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

III. EXAMINER ADOPTS IMPROPER TIME PERSPECTIVE (NAMELY, AT TIME REJECTION MADE)

The Examiner's obviousness rationale is replete with instances of having failed to cast his mind back to the time when the invention was made. Instead, the Examiner's obviousness rationale is corrupted by an improper time perspective rooted in his knowledge of the art as of the time of making the rejection. Examples of the Examiner's improper time perspective follow:

¹ The standard of obviousness is not what could have been made by the skilled artisan in view of the applied references, but what would have been made. See, e.g., MPEP §2143.01(II) ("Fact That Reference Can Be Combined Or Modified Is Not Sufficient To Establish Prima Facie Obviousness").

² See, e.g., MPEP §2141.01(III) ("Content Of The Prior Art Is Determined At The Time The Invention Was Made To Avoid Hindsight").

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EXAMINER'S ANSWER, PAGE 3, LINES 9-13

Since Brown has ..., it would be [present tense] obvious to one of ordinary skill in the art...

EXAMINER'S ANSWER, PAGE 5, LINES 13-16

One of ordinary skill in the art (suggested herein to be ... communications) recognizes [present tense] upon reading Brown that ...

EXAMINER'S ANSWER, PAGE 5, LINES 20-26

One of ordinary skill as defined above recognizes [present tense] the extensive amount of One of ordinary skill also recognizes [present tense] that distributed computing

One of ordinary skill as defined above is aware [present tense] that the distributed computing functions of Brown can be [present tense] easily implemented locally. The benefits of doing so are [present tense] obvious to one of ordinary skill in the art. ...

The above-quoted portions of the Examiner's rationale demonstrate that the Examiner's obviousness rationale is corrupted by an improper perspective rooted in his knowledge of the art as of the time of making the rejection. In addition, the Examiner's assertions (e.g., on page 5, lines 20-26) as to what the skilled artisan would understand (rather than would have understood) are conjecture, unsupported by evidence in the art.

Ironically, the Examiner acknowledges that a judgment of obviousness must adopt the proper time perspective, stating (Examiner's Answer, page 6, lines 10-11):

But so long as it [the judgment of obviousness] takes into account only knowledge which was within the level of ordinary skill at the time the invention was made, ...

Though the Examiner has acknowledged the proper time perspective, the above-quoted passages of his rationale demonstrate that the Examiner has not applied the proper time perspective.

There is a passage in the Examiner's rationale that if not considered carefully might be regarded as representing an instance of the Examiner adhering to the proper time perspective. It does not. That passage states (Examiner's Answer, page 6, lines 5-7):

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Brown was filed in 1996 -- six years before Appellant filed their application. Brown presented a more advanced version of Appellant's invention, and was patented three years before Appellant filed their simpler version of the Brown invention.

This statement by the Examiner merely comments upon the relative complexity of Appellant's invention. Complexity, however, is not the standard of patentability. Moreover, this statement does not reflect the requisite time perspective of a proper obviousness rationale.

In view of the foregoing discussion, the §103(a) rejections are improper at least because they adopt an improper time perspective.

IV. CONCLUSION

A proper obviousness rationale explains why the skilled artisan would (not could) have made the claimed invention, and does so from the time perspective of when the invention was made as a way to avoid a type of impermissible hindsight. Appellant has explained above how the Examiner's obviousness rationale is corrupted by a perspective rooted in his knowledge of the art as of the time of making the rejection, which is an improper time perspective. On this basis alone, the Examiner's conclusion of obviousness is improper due to impermissible hindsight. For this reasoning, and for the reasoning presented in Appellant's Appeal Brief, Appellant accordingly requests the Board to reverse the rejection and remand the application to the Examiner for preparation of a Notice of Allowance or a non-Final Office Action.

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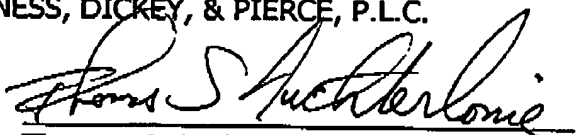
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The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-2025 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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